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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,330	12/17/2003	Michael Anthony Zerillo		7560

7590 03/30/2006

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EXAMINER

HAWK, NOAH CHANDLER

ART UNIT PAPER NUMBER

3637

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/737,330	<b>Applicant(s)</b> ZERILLO, MICHAEL ANTHONY	
	<b>Examiner</b> Noah C. Hawk	<b>Art Unit</b> 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.                                                             | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The reply filed on 1/3/06 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the submission is not fully responsive to the prior Office action because although the applicant has entered an amended set of claims, the applicant has failed to include remarks addressing all of the rejections made in the Non-Final Office Action dated 12/21/05. However, since the submission appears to be a bona fide attempt to provide a complete reply to the prior Office action, applicant's submission filed on 1/3/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrases "install-it-yourself," "adapts with little or no modification," and "that an average person can easily install" in all three claims appear to have no support in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding Claim 1, the phrase "to new and existing patio umbrellas of a type that operates by manually lifting and lowering a canopy opening and closing means on a support mast" renders the claim indefinite. The instant claim recites an "install-it-yourself electric opening and closing device" but includes language directed to an umbrella onto which the device may be installed. It is unclear whether the applicant intends to claim the "install-it-yourself electric opening and closing device" alone or in combination with the umbrella. For the purposes of examination, the Office interprets Claim 1 to be directed only to the "install-it-yourself electric opening and closing device." Any language regarding the umbrella will not be given any patentable weight. Additionally, the phrase "with little or no modification" renders the claim indefinite. It is unclear if the applicant intends little or no modification. Further, it is unclear whether modification (if necessary) will be to the "install-it-yourself electric opening and closing device" or to the umbrella on which it is installed. The phrase "an average person can easily install" is indefinite as people have different skill levels in this technology and what may be "easy" for some may be extremely difficult for others. The phrase

"located above the canopy opening and closing means" renders the claim indefinite, as the canopy opening and closing means is a movable component of any umbrella and the location of the claimed housing could change depending on where the opening and closing means is located at the time of construction.

b. Regarding Claim 2, the phrase "to new and existing patio umbrellas of a type that operates by rope and pulley that lifts and lowers a canopy opening and closing means on a support mast" renders the claim indefinite. The instant claim recites an "install-it-yourself electric opening and closing device" but includes language directed to an umbrella onto which the device may be installed. It is unclear whether the applicant intends to claim the "install-it-yourself electric opening and closing device" alone or in combination with the umbrella. For the purposes of examination, the Office interprets Claim 1 to be directed only to the "install-it-yourself electric opening and closing device." Any language regarding the umbrella will not be given any patentable weight. Additionally, the phrase "with little or no modification" renders the claim indefinite. It is unclear if the applicant intends little or no modification. Further, it is unclear whether modification (if necessary) will be to the "install-it-yourself electric opening and closing device" or to the umbrella on which it is installed. The phrase "an average person can easily install" is indefinite as people have different skill levels in this technology and what may be "easy" for some may be extremely difficult for others. The phrase "located above the canopy opening and closing means" renders the claim indefinite, as the canopy opening and closing means is a

movable component of any umbrella and the location of the claimed housing could change depending on where the opening and closing means is located at the time of construction.

c. Regarding Claim 3, the phrase “to new and existing patio umbrellas of a type that operates by a hand-controlled winch and cable that lifts and lowers a canopy opening and closing means on a support mast” renders the claim indefinite. The instant claim recites an “install-it-yourself electric opening and closing device” but includes language directed to an umbrella onto which the device may be installed. It is unclear whether the applicant intends to claim the “install-it-yourself electric opening and closing device” alone or in combination with the umbrella. For the purposes of examination, the Office interprets Claim 2 to be directed only to the “install-it-yourself electric opening and closing device.” Any language regarding the umbrella will not be given any patentable weight. Additionally, the phrase “with little or no modification” renders the claim indefinite. It is unclear if the applicant intends little or no modification. Further, it is unclear whether modification (if necessary) will be to the “install-it-yourself electric opening and closing device” or to the umbrella on which it is installed. The phrase “an average person can easily install” is indefinite as people have different skill levels in this technology and what may be “easy” for some may be extremely difficult for others. The phrase “located above the canopy opening and closing means” renders the claim indefinite, as the canopy opening and closing means is a movable component of any umbrella and the location of the claimed

housing could change depending on where the opening and closing means is located at the time of construction.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

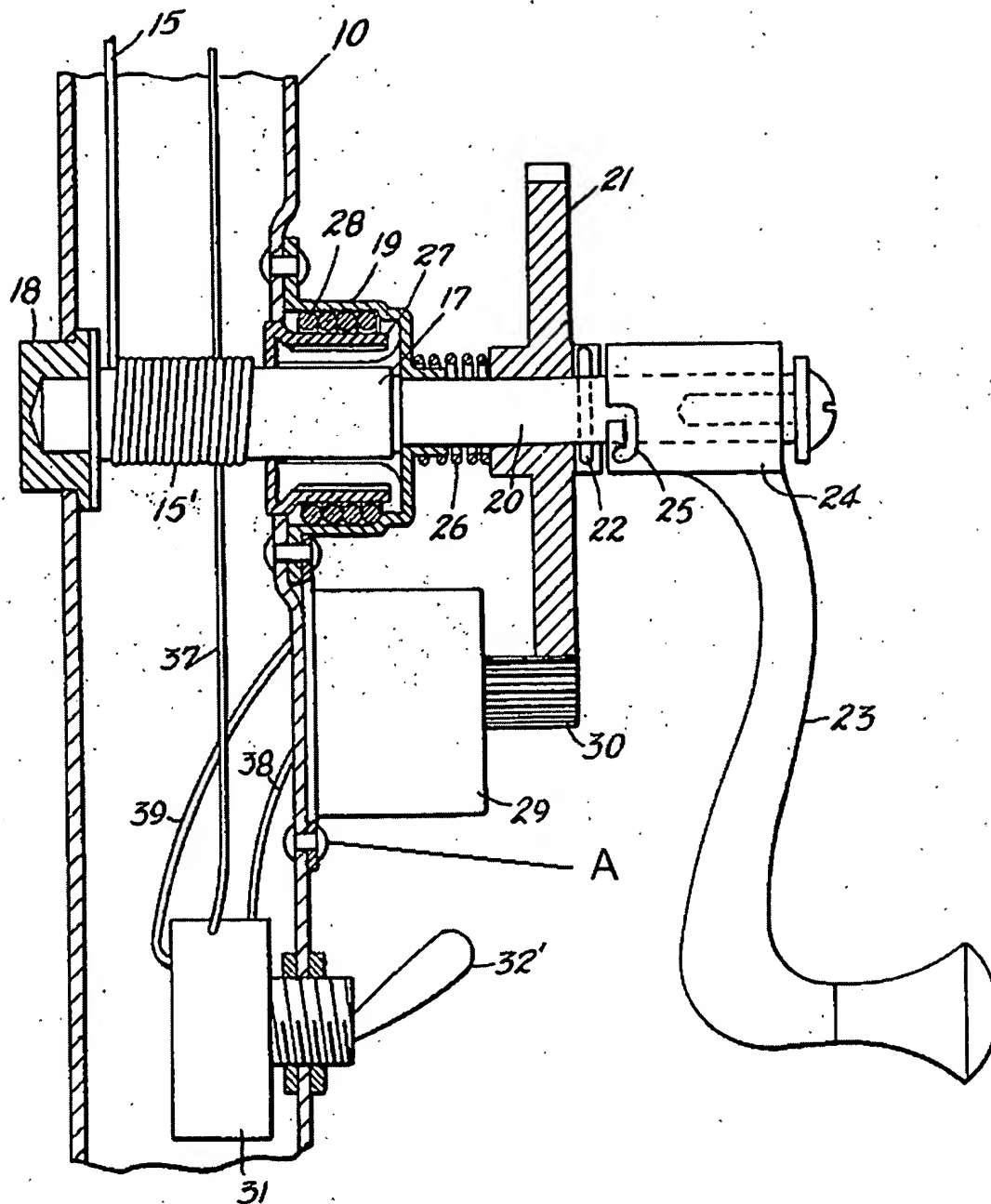
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Small in US Patent 2960094 in view of Lai in US Patent 6182917. Small discloses an "install-it-yourself" electric opening and closing device, the device comprising a housing means (19) installed to the outer surface of a support mast of an umbrella, an electric motor (29) and gear means (21,30) driving a cable reel (17) and mounted to the housing (Best seen in Small, Figure 2), a length of cable (15) having means to fix one end to the cable reel (see Small, Column 1, Line 54-55 "the lower end of the cord or cable 15 is secure to a drive shaft 17") and means to fix the opposite end to the canopy opening and closing means (13, see Small, Column 1, lines 52-53 "cable 15 passes with one end fixed to the runner 13"), a means to provide electricity (battery, 34), a motor control means to receive the electricity (32) and a manual switch (32') means that connects and disconnects the electricity to the motor and controls the motor start and stop (see Small, Column 2, lines 48-52) and direction of rotation (see Small, Column 2, lines 46-48) and drive the cable reel to collect and dispense the cable to lift and lower and stop the

canopy opening and closing means. Small fails to teach that the housing is installed using a plurality of screws or that is above the canopy opening and closing means or the use of a remote control transmitter/receiver apparatus to control the device.

However, Small appears to disclose rivets (A) as a means to attach the housing to the outer surface of the support mast. It is well known in the art to use screws as a substitute fastening device in place of rivets. Lai discloses an umbrella opening and closing device having a remote control receiver (11) connecting and disconnecting the electricity to a motor and controlling the motor start and stop and direction of rotation (see Lai, Column 4, lines 12-15) as well as a transmitter (see Lai, Column 2, lines 15-16, "an external remote controller") having means to control the remote control switch. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Small by using a remote control receiver and transmitter as taught by Lai in order to allow the user to operate the device at a distance and to use screws in place of rivets in order to allow the user to removably install the device. In addition, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of Small in view of Lai by mounting the housing above the canopy opening and closing means, since the applicant has not disclosed that having the housing mounted at this specific location solves any particular problem or imparts any distinct desirable characteristic to the opening and closing device and it appears that the device would perform equally well with a different placement of the housing.





Small, Figure 2

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Small in US Patent 2960094 in view of Lai in US Patent 6182917. Small discloses an "install-it-

yourself" electric opening and closing device, the device comprising a housing means (19) installed to the outer surface of a support mast of an umbrella, an electric motor (29) and gear means (21,30) driving a cable reel (17) and mounted to the housing (Best seen in Small, Figure 2), a length of cable (15) having means to fix one end to the cable reel (see Small, Column 1, Line 54-55 "the lower end of the cord or cable 15 is secure to a drive shaft 17") and means to fix the opposite end to the canopy opening and closing means (13, see Small, Column 1, lines 52-53 "cable 15 passes with one end fixed to the runner 13"), a means to provide electricity (battery, 34), a motor control means to receive the electricity (32) and a manual switch (32') means that connects and disconnects the electricity to the motor and controls the motor start and stop (see Small, Column 2, lines 48-52) and direction of rotation (see Small, Column 2, lines 46-48) and drive the cable reel to collect and dispense the cable to lift and lower and stop the canopy opening and closing means. Small fails to teach that the housing is installed using a plurality of screws or that is above the canopy opening and closing means or the use of a remote control transmitter/receiver apparatus to control the device. However, Small appears to disclose rivets (A) as a means to attach the housing to the outer surface of the support mast. It is well known in the art to use screws as a substitute fastening device in place of rivets. Lai discloses an umbrella opening and closing device having a remote control receiver (11) connecting and disconnecting the electricity to a motor and controlling the motor start and stop and direction of rotation (see Lai, Column 4, lines 12-15) as well as a transmitter (see Lai, Column 2, lines 15-16, "an external remote controller") having means to control the remote control switch. It

would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Small by using a remote control receiver and transmitter as taught by Lai in order to allow the user to operate the device at a distance and to use screws in place of rivets in order to allow the user to removably install the device. In addition, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of Small in view of Lai by mounting the housing above the canopy opening and closing means, since the applicant has not disclosed that having the housing mounted at this specific location solves any particular problem or imparts any distinct desirable characteristic to the opening and closing device and it appears that the device would perform equally well with a different placement of the housing.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Small in US Patent 2960094 in view of Lai in US Patent 6182917. Small discloses an "install-it-yourself" electric opening and closing device, the device comprising a housing means (19) installed to the outer surface of a support mast of an umbrella, an electric motor (29) and gear means (21,30) driving a cable reel (17) and mounted to the housing (Best seen in Small, Figure 2), a length of cable (15) having means to fix one end to the cable reel (see Small, Column 1, Line 54-55 "the lower end of the cord or cable 15 is secure to a drive shaft 17") and means to fix the opposite end to the canopy opening and closing means (13, see Small, Column 1, lines 52-53 "cable 15 passes with one end fixed to the runner 13"), a means to provide electricity (battery, 34), a motor control means to receive the electricity (32) and a manual switch (32') means that connects and

disconnects the electricity to the motor and controls the motor start and stop (see Small, Column 2, lines 48-52) and direction of rotation (see Small, Column 2, lines 46-48) and drive the cable reel to collect and dispense the cable to lift and lower and stop the canopy opening and closing means. Small fails to teach that the housing is installed using a plurality of screws or that is above the canopy opening and closing means or the use of a remote control transmitter/receiver apparatus to control the device.

However, Small appears to disclose rivets (A) as a means to attach the housing to the outer surface of the support mast. It is well known in the art to use screws as a substitute fastening device in place of rivets. Lai discloses an umbrella opening and closing device having a remote control receiver (11) connecting and disconnecting the electricity to a motor and controlling the motor start and stop and direction of rotation (see Lai, Column 4, lines 12-15) as well as a transmitter (see Lai, Column 2, lines 15-16, "an external remote controller") having means to control the remote control switch. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Small by using a remote control receiver and transmitter as taught by Lai in order to allow the user to operate the device at a distance and to use screws in place of rivets in order to allow the user to removably install the device. In addition, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of Small in view of Lai by mounting the housing above the canopy opening and closing means, since the applicant has not disclosed that having the housing mounted at this specific location solves any particular problem or imparts any distinct desirable characteristic to the opening and closing

device and it appears that the device would perform equally well with a different placement of the housing.

### ***Response to Arguments***

10. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-

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1480. The examiner can normally be reached on M-F 9am to 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/28/06

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